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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/395,294      | 09/13/1999  | SOPHIE WILSON        | 1073/OG117          | 5796             |

7590 01/16/2004  
DARBY & DARBY PC  
805 THIRD AVENUE  
NEW YORK, NY 10022

EXAMINER

MEONSKE, TONIA L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2183

DATE MAILED: 01/16/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Advisory Action**

Application No.

09/395,294

Applicant(s)

WILSON, SOPHIE

Examiner

Tonia L Meonske

Art Unit

2183

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

10. ☐ Other: \_\_\_\_\_

  
**RICHARD L. ELLIS**  
**PRIMARY EXAMINER**

Continuation of 5. does NOT place the application in condition for allowance because: On pages 2 and 3 of the remarks filed December 23rd, 2003, Applicant argues

"Applicant respectfully asserts that stating that the claims fail to define "how the detection occurs" is contradictory to the statement that the detection aspect is not recited in the claims (see text below with respect to bits contained within the instruction). Applicant wish to direct Examiner's attention to dependent claim 5. This claim recites the limitation that "the decode unit is operable to make the detection based on the values of a designated set of identification bits at predetermined bit location in the instruction." In view of the foregoing, Applicant respectfully asserts that the argument is not moot, based on the language set forth in independent claim 5 which demonstrates how the "detection" occurs."

However, Examiner respectfully points out that on page 8 of paper number 17, filed on July 3, 2003, Applicant was arguing with respect to independent claims 1, 8, 12, and 15 NOT the Dependent claim 5. On page 4, of paper number 18, mailed on September 23, 2003, Examiner was first addressing the argument with respect to the independent claims 1, 8, 12, and 15 as set out by Applicant. The language Applicant was arguing, i.e. identification bits within the instruction (for detecting), is not present in any of independent claims 1, 8, 12, and 15. Therefore the argument presented by Applicant on page 8 of paper number 17, filed on July 3, 2003 is moot. Secondly, for the convenience of the Applicant, the Examiner showed, on pages 4-5 in paper number 18 mailed on September 23, 2003, how Shiell et al., in view of Yoshida, have in fact taught the argued limitations that actually appear in claim 5. Therefore this argument is moot.